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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,054	05/26/2006	Rainer Breitenbach	INA-40	1220
20311 7590 02/21/2008 LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016				
EXAMINER GARCIA, ERNESTO				
ART UNIT PAPER NUMBER 3679				
MAIL DATE DELIVERY MODE 02/21/2008 PAPER				

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/596,054

**Applicant(s)**

BREITENBACH ET AL.

**Examiner**

ERNESTO GARCIA

**Art Unit**

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 May 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.  
4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 15-18 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 26 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Restriction*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-10, drawn to a method for producing a rotary joint between a drive element and a flange.

Group II, claims 11-14, drawn to device.

Group III, claims 15-18, drawn to a screwed joint.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

an assessment of the prior art with respect to the independent claims provides no unity of invention since the "special technical features", i.e., "the drive element and the flange being screwed together at least by a nut and a bolt" common in each of the independent claims is known from patent DE-19,543,436 A1. Applicant should note that the lack of unity is based on a *posteriori* and the special technical features, common to all inventions, do not define a contribution over the prior.

During a telephone conversation with Donald C. Lucas on February 11, 2008 a provisional election was made without traverse to prosecute the invention of Group III, claims 15-18. Affirmation of this election must be made by applicant in replying to this

Office action. Claims 1-14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the reference, DE-19,543,436C2, has been cited by the examiner on form PTO-892, they have not been considered.

Further, the listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application

specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Drawings***

The drawings are objected to because some of the reference characters are not readable and they appear as letters or special characters such as ^ for character 1. The solid black shading in the drive element in Figure 1-3 should not be used. See 37 CFR 1.84(m). Further, the flange 2, in Figure 1-4, is missing the proper cross-hatching since the flange is shown in cross-section. The same applies to the flange shown in Figures 8-13, the device 23 shown in Figure 5, 6, 9-13, the axial disks 14 shown in Figure 4a, and

the nut in Figure 7-13. Furthermore, the through holes 26 should not be threaded since the pins 25 are not threaded.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "12" and "13" have both been used to designate the same component in Figure 4. Further, reference character 12 should not be underline.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

Applicants are reminded of the proper language and format for an abstract of the disclosure. The language should avoid using phrases, which can be implied, such as, "The disclosure concerns", "The disclosure defined by this invention", "The disclosure describes", "The invention relates to", etc. Accordingly, the abstract is objected.

Further, applicants are reminded of the proper language and format for an abstract of the disclosure. The form and legal phraseology often used in patent claims, such as "means" in line 3 should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The disclosure is objected to because of the following informalities:

the brief description of the drawings is not included as a section. Note that all the figures are to be described in sequence. Further, the heading section "DETAILED DESCRIPTION OF THE INVENTION" is missing. Appropriate correction is required.

### ***Claim Objections***

Claim 15 is objected to because of the following informalities:

regarding claim 15, "the direction" in line 6 should be -- a direction--. Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 15, the metes and bounds of the claim is unclear. In particular, it is unclear what the screwed joint is being comprised of. There is an inconsistency between the language in the preamble and a certain portion in the body of the claim, thereby making the scope of the claim unclear. The preamble clearly indicated that the screwed joint is "for connecting a flange to a drive element of a drive shaft". However, the body of the claim positively recites "the drive element" and "the flange", e.g., "the drive element and the flange being screwed together" (lines 2-3), which indicates that the claims are being drawn to a combination of the "screwed connection" and both the "flange" and "drive element". Accordingly, is the combination or subcombination being claimed? Appropriate correction, clarification, or both is required. For purposes of this

Office action, the examiner has assumed the flange and the drive element being part of the screwed joint.

Regarding claim 16, the recitation "the nut is undercut by means of at least one radial recess" in lines 2-3 makes unclear whether this is another undercut than that recited in claim 15, lines 5-6, or the same undercut.

Regarding claim 17, the recitation "the is undercut with at least one annular groove" in lines 2-3 makes unclear whether this is still another undercut than that recited in claims 15, lines 5-6, and claim 16, lines 2-3, or the same undercut.

Regarding claim 18, the recitation "the nut being undercut on an outer side facing away radially from the internal thread" in lines 4-5 makes unclear whether this is another undercut than that recited in claim 15, lines 5-6, and claim 16, lines 2-3, or the undercut is the same one.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15-18, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Norman et al., 6,783,342.

Regarding claim 15, Norman et al. disclose, in Figure 3, a screwed joint comprising a flange **46**, a drive element **50**, a nut **36**, and a bolt **53**. The bolt **53** is on the drive element **50**. The drive element **50** and the flange **46** are screwed together at least by the nut **36** and the bolt **53**. The nut **36** is undercut axially at least on a portion **38** from a direction of the flange **46**. The portion **38** is spaced axially in relation to the flange.

Regarding claim 16, the undercut is at least one radial recess **40**.

Regarding claim 17, the radial recess is at least one annular groove **40** (col. 4, line 27).

Regarding claim 18, the bolt **53** has an external thread. The nut **36** has an internal thread corresponding to the external thread. The annular groove **40** is on an outer side facing away radially from the internal thread.

Claims 15-18, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Hetmann et al., 3,635,303.

Regarding claim 15, Hetmann et al. disclose, in Figure 2, a screwed joint comprising a flange **43**, a drive element **54**, a nut **57**, and a bolt (threaded portion where nut is threaded). The bolt is on the drive element **54**. The drive element **54** and the flange **43** are screwed together at least by the nut **57** and the bolt. The nut **57** is undercut axially at least on a portion **58** from a direction of the flange **43**. The portion **58** is spaced axially in relation to the flange **43**.

Regarding claim 16, the undercut is at least one radial recess **58**.

Regarding claim 17, the radial recess is at least one annular groove **58** (col. 4, line 6-8).

Regarding claim 18, the bolt has an external thread. The nut **57** has an internal thread corresponding to the external thread. The annular groove **58** is on an outer side facing away radially from the internal thread.

### ***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Niebling et al. show a similar prior art screwed joint. Mermoz, 7,192,213, Mekler, GB-2,171,040, and Nelsen et al., GB-2,301,548, and Japanese patents, JP4-349001, JP54-146303, and JP55-51601, show a similar screwed joint.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached from 9:30AM-6:00PM. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/E. G./

Examiner, Art Unit 3679

February 20, 2008

/Daniel P. Stodola/  
Supervisory Patent Examiner, Art Unit 3679